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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,144	07/12/2001	Alfred Blalock Bahnson	HOUCK-8	2387

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/904,144

Applicant(s)
Bahnson

Examiner
Christopher Tate

Art Unit
1654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 19, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 16, 17, 23, and 25-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 16, 17, 23, and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

The amendment filed June 19, 2003 is acknowledged and has been entered. Claims 1-9, 11, 12, 16, 17, 23, and 25-31 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 11, 12, 16, 17, 23, and 25-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly recited phrases "cell having an average straight line velocity of between 0 and 10 $\mu\text{m}/\text{min}$ " and "cell having an average straight line velocity of between 0 and 10 $\mu\text{m}/\text{min}$ in a solution containing a viscosity enhancement medium" (either or both of these phrases are recited in each independent claim) are deemed new matter. Applicants state that support for these phrases is found in instant Figure 3 (Figures 3A-3D). However, Figure 3 fails to adequately disclose a "human cell having an average straight line velocity of between 0 and 10 $\mu\text{m}/\text{min}$ ". At

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best, Figure 3 appears to show straight line cell velocities ranging between 0 and 10 $\mu\text{m}/\text{min}$ (which do not appear to be average straight line velocities) only in the context of cells which have been placed within solutions containing various particular low level concentrations of methyl cellulose. Accordingly, the instant specification apparently teaches straight line motility of cells which fall within the range of 0 to 10 $\mu\text{m}/\text{min}$ when the cells are placed in a solution to which particular low level amount ranges of methyl cellulose have been introduced (and not when placed in any undefined solution). Thus, the above new matter phrases are broader in scope than the instant teachings because they fail to properly include a correlation of the straight line velocity range of between 0 and 10 $\mu\text{m}/\text{min}$ - i.e., within a solution having a particular low level of methyl cellulose therein. Further, as discussed above, these phrase also constitute new matter by the term "average" therein because instant Figure 3 does not appear to reasonably pertain to the average straight line velocities of such cells.

All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under U.S.C. 112, first paragraph for the reasons set forth above.

Please note that removal of the above new matter phrases would likely necessitate reintroduction of the art rejections set forth in the previous Office action.

Claims 1-9, 11, 12, 16, 17, 23, and 25-31 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In each independent claim, the phrase "the ... cell having an average straight line velocity of between 0 and 10 $\mu\text{m}/\text{min}$ in a solution containing a viscosity enhancement medium" (or similar phraseology) is recited. There is insufficient antecedent basis for this limitation in these claims because the preamble of these claims does not adequately define the analyzed cell in this overall functional manner.

Claim 9 is rendered vague and indefinite by the grammatically awkward phrase "when there is no attachment to any surface of the cell involved" (last two lines) - e.g., is this attempting to define that there is no attachment of something to any surface of the cell, that there is no attachment of the cell to any surface, or something else?

Claim 12 is rendered vague and indefinite by the phrase "without adherence to any surface" (last two lines) because it is unclear as to the adherence of what - e.g., adherence of the cell or something else?

Claim 30 recites the limitation "the plate" in the last line. There is still insufficient antecedent basis for this limitation in the claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1654 is (703) 872-9306.



Christopher R. Tate
Primary Examiner, Group 1654